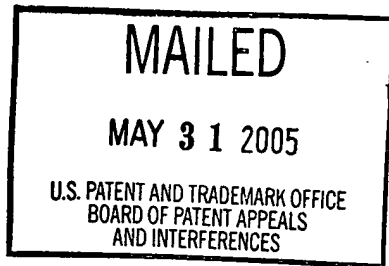


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 35



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERRY MICHAEL BLEIZEFFER, ALLAN EUGENE GILLESPIE, EILEEN
FELICIA KOPP, TONY KAI-CHI LEUNG and STAN WONG

Appeal No. 2005-0871
Application 09/248,736

ON BRIEF

Before HAIRSTON, KRASS and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the examiner's refusal to allow claims 1, 3-22, 24-43 and 45-63 as amended after final rejection. Claims 2, 23 and 44 have been canceled and claims 64-105 have been allowed.

THE INVENTION

The appellants claim a method, apparatus and article of manufacture for creating a customized tree from an original tree.

Claim 1, which claims the method, is illustrative:

1. A method of creating a customized tree in a computer from an original tree containing objects from a data storage device connected to the computer, the method comprising:

creating a filter in response to user input, wherein the filter specifies a selection criteria to select objects to be contained within a selected object on the customized tree;

saving the filter and the specified selection criteria;

selecting one or more objects on the original tree to be contained in the customized tree in response to user input by applying the filter, wherein the one or more objects are located in disparate places across different branches of the original tree;

linking the selected objects from the disparate places to each other in the customized tree in a user-specified manner; and

defining security restrictions for accessing the selected objects using the customized tree.

THE REFERENCES

Robinson	5,842,218	Nov. 24, 1998
Glasser et al. (Glasser)	5,956,715	Sep. 21, 1999
		(filed Sep. 23, 1996)
Cotugno et al. (Cotugno)	6,198,480	Mar. 6, 2001
		(filed Jan. 29, 1999)

OPINION

We reverse the aforementioned rejections.

Rejection under 35 U.S.C. § 112, first paragraph

The examiner argues that the appellants' originally-filed specification does not provide written descriptive support for the limitation in each of the appellants' independent claims of "saving the filter and the specified selection criteria" (answer, page 3).

The appellants' specification discloses that 1) a customized tree creator (118) creates, in response to user input from a displayed Add Folder to Tree window, a filter for selecting an object from an original tree to be contained in a customized tree, 2) the filter specifies selection criteria to select objects to be contained in the selected object in the customized tree, and 3) the customized tree creator applies the filter to create the customized tree with the selected object and the objects to be contained therein (page 14, line 28 - page 15, line 2). If tables upon which a filter is applied change after a filter has been created, then upon receipt of a command such as a REFRESH command the filter automatically modifies the customized tree to reflect the changed tables (page 11, lines 15-17). When a user is satisfied with the filter that has been created the

user may lock the values by clicking "OK" (page 11, lines 22-23). Figure 17 shows a Change Folder window which differs from the Add Folder to Tree window (figure 12) only in that the Change Folder window reflects selections previously made (page 14, lines 11-14). Filtering criteria may be changed by a user if different criteria are desired (page 14, lines 16-17). Changes made by a user take effect when the user clicks the "OK" button, those changes are saved, and the contents of the object which had been selected are reflected in the contents of a folder displayed in a subwindow when the object is selected (page 14, lines 17-22).

The examiner argues that the appellants' figure 17 shows a user interface for defining a filter but does not provide any mechanism for saving the filter and the specified selection criteria (answer, pages 3-4). The appellants' disclosure that the Change Folder window in figure 17 reflects the selections previously made indicates that the filter and selection criteria used to make those previous selections have been saved such that they are available to reflect the previous selections.

The examiner argues that the appellants' disclosure that "[t]he changes would have to be saved, for example, with the "Save" action 1411 and the contents of the object which had been selected 1607, may change as appropriate" (page 14, lines 18-20) pertains to saving the tree objects, not the filter (answer, page 4). In the immediately preceding portion of the specification the appellants disclose that the filtering criteria may be changed by the user if different criteria are desired, and that those changes take effect when the user clicks on the "OK" button (page 14, lines 16-18). Thus, the sentence quoted by the examiner pertains to saving the filtering criteria.

The examiner correctly argues (answer, page 4) that the appellants disclose how a new customized tree can be saved (page 14, lines 1-4). However, in the above-cited other portions of the specification the appellants disclose saving a filter and specified selection criteria.

The examiner argues, based upon a dictionary definition, that saving requires transferring data from a computer's random access memory, where the data is vulnerable to erasure, to a storage medium such as a disk drive, and that the appellants do not disclose that their filter and specified selection criteria are saved in that manner (answer, pages 10-11). The examiner

argues that the appellants' disclosure that clicking on "OK" locks in the values (specification, page 11, lines 22-23; page 14, lines 17-18) indicates that the selection criteria are retained in the computer's temporary memory but are not saved in permanent memory (answer, page 11). As stated in *Hormone Research Foundation Inc. v. Genentech Inc.*, 904 F.2d 1558, 1563, 15 USPQ2d 1039, 1043 (Fed. Cir. 1990), "[i]t is a well-established axiom in patent law that a patentee is free to be his or her own lexicographer [citation omitted], and thus may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings. For this reason, an analysis of the specification and prosecution history is important to proper claim construction." The examiner has not analyzed the specification and prosecution history and explained why they indicate that the appellants' claim term "saving" is to be interpreted as limited to saving in permanent memory.

The examiner argues that the appellants do not disclose that their table filter is saved (answer, pages 11-12). What the appellants' claims require is that the filter and the specified selection criteria are saved. Such saving is indicated by the above-discussed portions of pages 11 and 14 of the appellants' specification.

For the above reasons we find that the examiner has not carried the burden of establishing a *prima facie* case of lack of written descriptive support for the appellants' claimed invention.

Rejection under 35 U.S.C. § 103

The examiner relies upon Cotugno for a disclosure of the appellants' claim limitation of saving a filter and specified selection criteria (answer, page 5). The appellants argue that their provisional application predates Cotugno as to that limitation (brief, pages 8-9).¹

The appellants' provisional application discloses, in figure 6, an Add Folder to Tree window that includes a folder label box for a folder label which may provide an indication of a filter (page 8, lines 4-10). The Add Folder to Tree window enables a user to provide table filter information which is filter criteria for determining which tables are to be contained in a folder object (page 8, lines 10-12). A Change Folder window, shown in figure 16, is the same as the Add Folder to Tree window except that the Change Folder window reflects the

¹ Cotugno, filed on January 29, 1999, has a provisional application date of October 7, 1998, whereas the appellants' application, filed on February 12, 1999, has a provisional application date of April 10, 1998.

selections previously made (page 10, lines 4-6). The user makes changes to the Change Folder window and those changes take effect when the user clicks on the "OK" button (page 10, lines 6-7). The changes are saved with a "Save" action (page 10, line 8).

The examiner argues that the above-discussed portions of the appellants' provisional application "do not describe that the filter and the specified selection criteria are 'transferred to a storage medium' nor 'stored as a file'" (answer, page 12). The examiner, however, has not established that "saving", as that term is used by the appellants, is limited to saving in the manner argued by the examiner.

The above-discussed disclosures in the appellants' provisional application that the Add Folder to Tree window enables a user to provide filter criteria for determining which tables are to be contained in a folder object, and that a user's changes to the Change Folder window, which is the same as the Add Folder to Tree window except that the Change Folder window reflects the selections previously made, take effect when the user clicks on the "OK" button and are saved with a "Save" action, indicate that the filter and specified selection criteria are saved.


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The appellants' provisional application, therefore, predates Cotugno as to the disclosure therein relied upon by the examiner. Because Cotugno is not prior art as to that disclosure, the examiner's rejection cannot be sustained.


DECISION

The rejections of claims 1, 3-22, 24-43 and 45-63 under 35 U.S.C. § 112, first paragraph, written description requirement, and under 35 U.S.C. § 103 over Robinson in view of Glasser and Cotugno, are reversed.

REVERSED


KENNETH W. HAIRSTON
Administrative Patent Judge


ERROL A. KRASS
Administrative Patent Judge


TERRY J. OWENS
Administrative Patent Judge

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